

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Petition for Reconsideration of Holding of Abandonment
or, Alternatively,
Petition for Revival of Unintentionally Abandoned
Application,
and
Conditional Request for Refund

Inventor:

**James A. Barger, Sr. and
Paul J. Hubbell, Jr.**

Invention:

PORTABLE CRANE/WINCH/HOIST

Prepared by:

RAYMOND G. AREAUX, (Reg. 33,643)

*Carver, Darden, Koretzky, Tessier,
Finn, Blossman & Areaux, L.L.C.*

1100 Poydras Street
Energy Centre Suite 2700
New Orleans, LA 70163
(Telephone: 504/585-3803)
(Facsimile: 504/585-3801)

(P/A File ID: 15294)

[Filed: June 8, 2007]

SUMMARY OF ARGUMENT

The petitioners respectfully suggest that the Notice of Abandonment mailed on May 22, 2007 is not well taken and requests reconsideration of the holding of abandonment per 37 C.F.R. § 1.181(a). The petitioners further suggest that their response, filed on February 19, 2007, to the First Notice of Non-Compliant Amendment (the “First Notice”) mailed on August 18, 2006 was a bona fide attempt to advance the application proceeding to final action, thus satisfying the requirements of 37 C.F.R. § 1.111(b) and justifying a reversal of the holding of abandonment.

Alternatively, the petitioners assert that any alleged abandonment was unintentional and request that their application be revived per 37 C.F.R. § 1.137(b). Specifically, the petitioners respectfully assert that their response to the First Notice, as well as their response (filed on May 10, 2007) to the Second Notice of Non-Compliant Amendment (the “Second Notice”) mailed on May 3, 2007 – both filed before the Notice of Abandonment was mailed – evidence the petitioners’ intent to advance the application to final action and not abandon said application.

ANALYSIS

I. Factual Background

Undersigned counsel briefly reviewed a limited number of records in this case in early February 2007 when first contacted by the petitioners. At that time, the petitioners informed undersigned counsel that they had been unsuccessful in contacting their then

attorney of record for several months. Not knowing whether or not petitioners' then attorney of record had filed, had prepared, or was planning on filing, a response to the then outstanding matter (and undersigned counsel not wanting to prematurely prepare and file a reply – especially in a case with which they were unfamiliar), undersigned counsel initially directed efforts toward contacting then counsel of record. After several attempts, undersigned counsel was similarly unsuccessful in contacting petitioners' then counsel of record. Thus did the petitioners find themselves in an unexpected, unintended, unfortunate and undesirable situation in mid-February of 2007 as the then response deadline loomed without any apparent prospect of receiving any assistance from the then counsel of record.

On February 15, 2007, the petitioners, still without the benefit of knowing what, if anything, their then attorney of record had done or was planning to do to advance the case, purposely elected to take charge of the matter and thus filed, through undersigned counsel, a change of attorney form revoking the then counsel of record's power of attorney and naming undersigned counsel as attorney of record. The Notice of Acceptance of said form was mailed on February 28, 2007. On February 19, 2007, the petitioners filed their response, through undersigned counsel, to the First Notice in a bona fide effort to satisfy the deficiencies cited in said First Notice.

On May 3, 2007, the Second Notice was mailed to the petitioners citing omissions in the petitioners' response to the First Notice **and expressly granting the**

petitioners a 30-day period to reply. Receiving the Second Notice on May 7, 2007, the petitioners, in an effort to aggressively move their application to final action, immediately replied to the Second Notice by filing a response addressing all cited deficiencies on May 10, 2007 – thus responding within 3 business days and certainly well in advance of the 30 day deadline explicitly granted by the Second Notice.

On May 22, 2007, an apparently errant (at least from petitioners' perspective) Notice of Abandonment was mailed to the petitioners. This Notice of Abandonment made no mention of the Second Notice, nor did it mention the petitioners' response to same, but instead merely stated that the petitioners' response of February 19, 2007 was insufficient and that the application was, to petitioners' total and complete surprise, considered abandoned.

II. Petition to the Director for Reconsideration of the Holding of Abandonment

A. Petitioners' Response to the First Notice

Setting aside, for the moment, the express grant of a 30-day reply via the Second Notice (as well as petitioners' prompt and complete reply thereto) and thus, viewing this matter for sake of argument as if the Second Notice has no bearing on the question, the holding of abandonment nevertheless appears not to be well taken. Pursuant to 37 C.F.R. § 1.181(a), the petitioners respectfully request that the holding of abandonment in this case be reconsidered and subsequently reversed. So long as an applicant's

response to a non-final office action “appear[s] throughout to be a bona fide attempt to advance the application...to final action,” the applicant is entitled to reconsideration. 37 C.F.R. § 1.111. Further, when the reply by an applicant is a bona fide attempt to advance the application to final action, “and is substantially a complete reply to the non-final Office action,” then the applicant may be given more time to reply if “compliance with some requirement has been inadvertently omitted” even if there is no more time left to reply. 37 C.F.R. § 1.135(c).

With regard to whether a reply substantially responds to an Office action, the Manual of Patent Examination Procedure (“MPEP”) states that “minor deficiencies” such as a failure “to treat every rejection, objection, or requirement” are not necessarily enough to warrant a finding that a response is not a bona fide response (which would bar the Examiner from granting additional time to correct said “minor deficiencies”). MPEP § 714.03. In fact, the MPEP states that even serious omissions are not necessarily a bar to an extension of time under § 1.135(c) so long as the response is a bona fide attempt to move toward final action.

In this case, no explanation is given by the Examiner as to why the petitioners’ response to the First Notice should not be considered a bona fide attempt to move toward final action. The failure to include Claims 21 through 35 in the response to the First Notice was inadvertent at worst. The petitioners were under the (apparently mistaken) impression that a response to a Notice of Non-Compliant Amendment was a

correction of the already-filed Amendment Document of March 3, 2006 and not a replacement for said Amendment Document. Thus, only corrections to the deficiencies cited in the First Response were addressed.¹

The petitioners respectfully suggest that a better view is to look not only at what was omitted in their response to the First Notice, but what was included. The changes to not only Claims 1 thorough 20, but also to the Specification, evidence the petitioners' intent to submit a good faith response to the deficiencies cited in the First Notice so that prosecution of their application could move forward to final action. The intent of the MPEP in precluding applicants from receiving the benefits of § 1.135(c) in cases where deliberate omissions are made is not meant to punish applicants such as the petitioners – who only inadvertently failed to meet a technical requirement. Rather, the guidelines of the MPEP and the associated Federal Regulations are meant to prevent abuse of the application process by those seeking to surreptitiously delay or prolong the prosecution of their applications. Such is certainly not the case in this instance – especially in view of petitioners' burden and response arising from the unfortunate turn of events and uncertainties related to petitioners' prior counsel of record.

The petitioners respectfully submit that the content of their response to the First Notice, as well as their prompt and complete response to the Second Notice, evidence

¹ While it is true that the descriptor for Claims 21, 27 and 28 were changed from "Newly Added" to "Withdrawn – Newly Added" in the response to the Second Notice, the failure to adjust these descriptors in response to the First Notice was pure oversight and in no way a deliberate omission.

the fact that the petitioners had no other goal than to submit a good faith response to the First Response in a bona fide attempt to move their application toward final action. Consequently, petitioners respectfully request that the holding of abandonment be reversed and that their response to the Second Notice be duly examined.

B. Petitioners' Response to the Second Notice

Petitioners maintain that their response to the First Notice is, on its own, a bona fide response such that the holding of abandonment should be reversed. However, petitioners respectfully suggest that the Second Notice should not be ignored in this analysis. The fact that the Second Notice provided an express grant of additional time, in conjunction with the petitioners' prompt reply to same, is a compelling reason for granting the relief sought in this Petition for Reconsideration.

Moreover, the grant of the 30-day extension made in the Second Notice is at least an implicit holding and decision in the record that the petitioners' reply of February 19, 2007 was a "bona fide attempt to advance the application to final action" and further constituted a "substantially complete reply" to the First Notice. Nothing in the record supports any other interpretation of the impact of the issuance of the Second Notice. Therefore, in light of these arguments, and all of those set forth above, petitioners respectfully request that the holding of abandonment be reversed so that the prosecution of their application may continue.

III. Alternative Petition for Revival of an Application for Patent Abandoned Unintentionally

Alternatively, petitioners respectfully request that their application be revived pursuant to 37 C.F.R. § 1.137(b) as it was unintentionally abandoned. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 C.F.R. § 1.137(b) was unintentional.

As stated above, a reply to the First Notice was timely filed on February 19, 2007. Moreover, as stated above, the substance of said reply evidences the petitioners' intent to advance the prosecution of their application toward final action. This evidence of the petitioners' intent is further supported by the fact that petitioners have already filed a reply in response to the Second Notice which addresses any and all issues upon which the holding of abandonment may be based. The fact that the response to the Second Notice was filed approximately two weeks before the Notice of Abandonment was mailed unequivocally demonstrates that the petitioners intended at all times to prosecute their application. Further, the unfortunate uncertainties related to petitioners' prior counsel of record and the need to enroll new counsel on the eve of the pending deadline further speak to the good faith intentions of the petitioners at all times. Therefore, petitioners respectfully assert that any abandonment is clearly and necessarily unintentional.

IV. Conditional Request for Refund of Fee

Petitioners respectfully request that, pursuant to 37 C.F.R. § 1.26 and MPEP § 607.02, the fee paid in association with their Petition for Revival be refunded in the event that their Petition for Reconsideration be granted and the holding of abandonment be reversed, thereby mooted their Petition for Revival. As the petitioners have paid the required fee via authorization to charge undersigned counsel's deposit account, any refund should be returned to undersigned counsel's deposit account.

V. Conclusion

Petitioners respectfully suggest that their response of February 19, 2007 was a bona fide attempt to move their application to final action; and, consequently, the holding of abandonment should be reversed. The facts cannot support the premise that the deficiencies of the response of February 19th were a result of a deliberate omission on the part of the petitioners. Therefore, there is no prohibition against allowing the petitioners to address the deficiencies cited in the Second Notice – especially in light of the fact that said deficiencies have already been addressed in the response to the Second Notice filed on May 10, 2007.

Additionally, the Second Notice (May 3, 2007) is best viewed as an implicit acknowledgement and decision that the petitioners' reply of February 19, 2007 sufficed to arise above any abandonment standard, which acknowledgement and decision cannot be ignored or retroactively muted.

Alternatively, should the holding of abandonment be upheld, the petitioners respectfully suggest that any abandonment that may have occurred was unintentional; and, that the petitioners' application should be revived.

Finally, should the holding of abandonment be reversed thereby mooted the petitioners' Petition for Revival, petitioners' request that the fee paid in association with the Petition for Revival be refunded to undersigned counsel's deposit account.

Respectfully submitted,

/Raymond G. Areaux/

Raymond G. Areaux (#33,643)
Direct Telephone: (504) 585-3803
Carver, Darden, Koretzky, Tessier, Finn,
Blossman & Areaux, L.L.C.
1100 Poydras Street
2700 Energy Centre
New Orleans, LA 70163
Main Telephone: (504) 585-3800
Facsimile: (504) 585-3801